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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,565	01/23/2004	Philippe Gambier	68.0418	4887

35204 7590 01/16/2007

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EXAMINER	
COY, NICOLE A	
ART UNIT	PAPER NUMBER
3672	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/16/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/763,565	GAMBIER, PHILIPPE	
	Examiner	Art Unit	
	Nicole Coy	3672	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 October 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *25-27 and 31-50* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *25-27,31-42,49 and 50* is/are allowed.

6)☒ Claim(s) *43-46* is/are rejected.

7)☒ Claim(s) *47 and 48* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 43 and 44 are rejected under 35 U.S.C. 102(e) as being anticipated by Simpson et al. (US 2002/0189696).

With respect to claim 43, Simpson et al. discloses a seal element for use in a packer comprising: an energizing element (62) adapted to store potential energy prior to the packer being run to a predetermined position in a well (wherein 62 inherently stores potential energy before it expands; see figures 6 and 7); a sealing layer (64) covering at least a portion of the energizing element; and a mechanism (71) adapted to hold the energizing element in a first position prior to the packer being run into the well to store the potential energy and release the energizing element downhole in the well to release at least some of the potential energy at the predetermined position to radially expand the energizing element and establish contact between the sealing layer and a wall enclosing the packer (see figures 6 and 7, wherein the mechanism 71 is capable of holding the energizing element 62 in a first position prior to the packer being run into the well).

With respect to claim 44, Simpson et al. discloses that the energizing element (62) comprises a metallic substrate.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Simpson et al.

With respect to claim 45, Simpson et al. does not disclose that the energizing element comprises a composite. It would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have used a composite material for the energizing element, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

5. Claim 46 is rejected under 35 U.S.C. 103(a) as being unpatentable over Simpson et al. in view of Patel (US 2002/0121373).

With respect to claims 46 and 47, Simpson et al. does not disclose pins or springs. It is well known that a spring loaded pins and ratchets are interchangeable as retention features. It would have been considered obvious to one of ordinary skill in the

art, at the time the invention was made, to have used a pin as a mechanism or spring as an energizing element as taught by Patel as they are known interchangeable retention features.

Allowable Subject Matter

6. Claims 25-27, 31-42, 49, 50 are allowed.

7. Claims 47 and 48 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

8. Applicant's arguments, filed 10/31/06, with respect to the spec and claim objections and the 112 rejections have been fully considered and are persuasive. The objection to the specification, objections of claims 31 and 37-42, and rejections of claims 44 and 45 under 112 have been withdrawn.

With respect to claim 43, Applicant admits that ratchet ring 71 may have the potential of energizing the slotted tubing 62 once the tubing is in position for the packer 60. As noted above, mechanism 71 is capable of holding the energizing element 62 in a first position prior to the packer being run into the well, thus this claim is not allowable over the prior art of record.

With respect to claim 45, the Applicant has argues that the Examiner has failed to show where the prior art discloses a composite material that could replace the

function of the slotted tube 62. However, composite slotted tubing is known in the prior art and as noted above, it would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have used a composite material for the energizing element, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

With respect to claim 46, the Applicant challenges the examiner and requests a reference to support the Examiner's position. Examiner points Applicant to Patel, which teaches that ratchets and pins are interchangeable as retention features.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Richard et al. (US 2006/0013088) teaches that expandable composite tubulars are used in order to easily and rapidly deploy a tubular into the wellbore.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicole Coy whose telephone number is 571-272-5405. The examiner can normally be reached on M-F 7:30-5:00, 1st F off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

William Neuder
Primary Examiner

nac